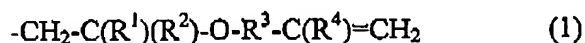


Application No. 10/763,268  
 Amendment dated April 20, 2006  
 Reply to Office Action of December 20, 2005

Docket No.: 21581-00160-US3

### REMARKS

Claims 12-30, 38-49 and 51-56 are now in the application. The allowance of claims 38-49 is hereby noted with appreciation. Claims 12 and 55 have been amended to recite "to vinyl polymer having an alkenyl group of the following general formula (1) at at least one terminus of its main chain:



wherein  $\text{R}^1$  and  $\text{R}^2$  are the same or different, and each represents a hydrogen atom or a univalent organic group derived from the group bound to a vinyl group of a vinyl monomer used for the production of a main chain of the polymer;  $\text{R}^3$  represents a divalent organic group having 1 to 20 carbon atoms and optionally containing one or more ether or ester bonds;  $\text{R}^4$  represents hydrogen, an alkyl group having 1 to 10 carbon atoms, an aryl group having 6 to 10 carbon atoms, or an aralkyl group having 7 to 10 carbon atoms" in place of "to the polymer according to claim 13" or "to the vinyl polymer having an alkenyl group at at least one terminus of its main chain according to claim 13", respectively. Claims 12 and 55 have been amended to recite the content of original claim 1 for purposes of clarification. These claims originally depended from claims 1-11, which have been cancelled.

Claims 13, 22, 51, 55 and 56 have been amended to recite "a univalent organic group derived from the group bound to a vinyl group of a vinyl monomer used for the production of a main chain of the polymer" in place of "a univalent organic group" concerning  $\text{R}^1$  and  $\text{R}^2$ . This recitation finds basis on page 7, lines 12-17 in the specification.

Claims 22 and 56 have been amended to recite " $-\text{CH}_2-\text{C}(\text{R}^1)(\text{R}^2)-\text{C}(\text{R}^6)(\text{R}^7)-\text{R}^8-\text{CH}(\text{R}^9)-\text{CH}_2-[\text{Si}(\text{R}^{10})_{2-b}(\text{Y})_b\text{O}]_m-\text{Si}(\text{R}^{11})_{3-a}(\text{Y})_a$ " in place of " $-\text{CH}_2-\text{C}(\text{R}^1)(\text{R}^2)-\text{C}(\text{R}^6)(\text{R}^7)-\text{R}^8-\text{C}(\text{R}^9)-\text{CH}_2-[\text{Si}(\text{R}^{10})_{2-b}(\text{Y})_b\text{O}]_m-\text{Si}(\text{R}^{11})_{3-a}(\text{Y})_a$ " to correct a typographical error for purposes of clarification. This amendment finds support at page 5, lines 4-5 of the specification. Claims 22, 38, 55 and 56 have been amended to correct some typographical errors. Claims 13, 22, 38, 44 and 51 have been amended by removing superfluous parenthesis and/or brackets for purposes of clarification.

The amendments to the claims do not introduce any new matter.

Application No. 10/763,268  
Amendment dated April 20, 2006  
Reply to Office Action of December 20, 2005

Docket No.: 21581-00160-US3

Concerning the Information Disclosure Statement filed May 25, 2005, there was no second page. The reference to 1 of 2 was a typographical error and should be 1 of 1.

Concerning the Priority claim under 35 USC 119, it is requested that in the next communication from the USPTO that the Examiner mark the items "12", "a", and "3" with a X, since the Japanese priority documents were received in applicant's parent application from the International Bureau.

Claims 22-30 and 56 were rejected under 35 USC 112, second paragraph in the definition of the R<sup>9</sup> Group. This rejection has been overcome the above amendments to the claims 22 and 56.

Claims 12-20 and 52-56 were rejected under 35 USC 102(e) as being anticipated by or in the alternative under 35 USC 103(a) as being obvious over U.S. patent 5,986,017 to Kusakabe et al. Claim 51 was also rejected under 35 USC 102(e) as being anticipated by U.S. patent 5, 986, 014 to Kusakabe et al. (hereinafter also referred to as "Kusakabe"). Kusakabe fails to anticipate claims 12-20 and 51-56.

Kusakabe does not disclose the vinyl polymer which has an alkenyl group or a silyl group of the formula (1), (5) or (6) according to the above claims. Namely, Kusakabe discloses neither the structure of formula (1) of the present invention, in which an oxygen atom is directly bonded to a carbon atom having R<sup>1</sup> and R<sup>2</sup> derived from the group bound to a vinyl group of a vinyl monomer, nor the structures according to formulae (5) and (6) of the present invention, in which a carbon group having an electron-withdrawing group (at least one of R<sup>6</sup> and R<sup>7</sup>) is directly bonded to a carbon atom having R<sup>1</sup> and R<sup>2</sup> derived from the group bound to a vinyl group of a vinyl monomer.

In addition, as appreciated by the Examiner, formula (5) of the present invention differs from the formula (D) obtained by reacting the formula (1) with the formula (3) of Kusakabe. Moreover, as the Examiner recognizes, the formula (6) of the present invention differs from the formula (A) obtained by reacting the formula (1) with the formula (7) of Kusakabe. Furthermore, although the Examiner mentions that the partial structure of the formula (2) of Kuskabe is equivalent to the formula (1) (R<sup>1</sup>, R<sup>2</sup>: a hydrogen, R<sup>3</sup>: a single bond) of the present invention, R<sup>3</sup>

Application No. 10/763,268  
Amendment dated April 20, 2006  
Reply to Office Action of December 20, 2005

Docket No.: 21581-00160-US3

of the formula (1) does not represent a single bond as defined in the above claims. Even if the formula (1) of the present invention is compared with an alkenyl group obtained by reacting the formula (1) with the formula (2) of Kusakabe, the formula (1) of the present invention differs from the alkenyl group obtained in Kusakabe.

Accordingly, Kusakabe discloses neither the vinyl polymer of the present invention having the alkenyl group or the silyl group of the formula (1), (5) or (6) nor the method for preparing the vinyl polymer of the present invention. Moreover, Kusakabe does not disclose the curable composition containing the vinyl polymer of the present invention. Consequently, the present invention differs from Kusakabe, and it is novel.

Kusakabe fails to anticipate claims 12-20 and 51-56 since anticipation requires the disclosure, in a prior art reference, of each and every recitation as set forth in the claims. *See Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985), *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986), and *Akzo N.V. v. U.S. International Trade Commissioner*, 1 USPQ2d 1241 (Fed. Cir. 1986).

There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. 102. *See Scripps Clinic and Research Foundation v. Genetech, Inc.*, 18 USPQ2d 1001 (CAFC 1991) and *Studiengesellschaft Kohle GmbH v. Dart Industries*, 220 USPQ 841 (CAFC 1984).

The rejection of Claims 22-30 and 56 under 35 USC 103(a) as being obvious over U.S. patent 5,986,017 to Kusakabe et al. is not tenable in view of 35 USC 103(c). In particular, Kusakabe and the present application are both owned by the same entity, Kaneka Corporation, and were commonly owned at the time the invention of this application was made. See the attached Declaration by the undersigned.

Application No. 10/763,268  
Amendment dated April 20, 2006  
Reply to Office Action of December 20, 2005

Docket No.: 21581-00160-US3

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 21581-00160-US3 from which the undersigned is authorized to draw.

Dated: 4-20-06

Respectfully submitted,

By 

Burton A. Amernick

Registration No.: 24,852

CONNOLLY BOVE LODGE & HUTZ LLP

1990 M Street, N.W., Suite 800

Washington, DC 20036

(202) 331-7111

(202) 296-6229 (Fax)

Attorney for Applicant